

REMARKS/ARGUMENTS

Claims 1-13, 15-24, and 26-35 are now pending in this application. Claims 1, 18 and 31 are independent claims. Claims 1, 15, 16, 18 and 31 have been amended. Claims 14 and 25 have been cancelled. Support for the current amendments may be found throughout the specification and drawings as filed.

Claim Rejections – 35 USC § 102(b)

Claims 1-4, 7-9, 11, 13-19, 21-22, 26-27 and 29-35 were rejected under 35 U.S.C. § 102(b) as being anticipated by Taylor, United States Patent Number: 4,825,496 (hereinafter: Taylor). Claims 1-4, 6-9, 11, 14-19, 21-22, 24, 26-27 and 30-35 were rejected under 35 U.S.C. § 102(b) as being anticipated by James, Jr., United States Patent Number: 3,138,815 (hereinafter: James). Claims 1-3, 7-9, 11, 14-15, 17-18, 22, 24, 26-27 and 30-35 are rejected under 35 U.S.C. § 102(b) as being anticipated by Cutler, United States Patent Number: 4,825,496 (hereinafter: Cutler). Claims 1-5, 7-8, 11, 14-15, 17, 31-33 and 35 were rejected under 35 U.S.C. § 102(e) as being anticipated by Dickerson, United States Patent Number: 6,523,209 (hereinafter: Dickerson). Claim 14 has been cancelled, thereby rendering moot the rejections to claim 14 under this section. Applicant respectfully traverses the remaining rejections under this section.

With particular attention to claim 1, but is generally applicable to the other claims, claim 1 recites a marine and pool cleaner. Further, claim 1 recites that the marine and pool cleaner includes “a hanger coupled with the transport assembly, the hanger configured for storing the transmission assembly.” Support for these elements can be found in the specification (Present Application, Page 9, Paragraph 0017) and drawings of the present application as filed. None of the cited references teach these limitations. In the present case, the Office has failed to cite any teaching in any of the references which would anticipate a marine and pool cleaner having a hanger coupled with the transport assembly, the hanger configured for storing the transmission assembly. Additionally, claim 18 also recites that the marine and pool cleaner includes “a flex drive cable including a strain reliever assembly for minimizing sharp bending.” None of the above cited references teach these limitations. In the present case, the Office has failed to cite

any teaching in any of the above cited references which would anticipate a marine and pool cleaner having a flex drive cable including a strain reliever assembly for minimizing sharp bending. As the Office is aware, in order to prove a *prima facie* case of anticipation, “a single prior source must generally contain all of the essential elements of the claim.” *W.L. Gore & Assoc. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, “the prior art reference must disclose each element of the claimed invention arranged as in the claim.” *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)). Emphasis added. Anticipation cannot be established when “the prior art is lacking or missing a specific feature or the structure of the claimed invention.” *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)). Emphasis added. None of the above cited references describe each and every limitation sufficient to anticipate the claimed invention.

In light of the foregoing, Applicant respectfully submits a *prima facie* case of anticipation is not shown, therefore, removal of the pending rejections under 35 U.S.C. §102 to claims 1-9, 11, 13, 15-19, 21-22, 24, 26-27, 29-35 is requested and allowance is earnestly solicited.

Claim Rejections – 35 USC § 103

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Taylor in view of James, Cutler in view of James or Dickerson in view of James. Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Taylor in view of Walker et al., United States Patent Number: 5,156,191 (hereinafter Walker), or Cutler in view of Walker or James in view of Walker or Dickerson in view of Walker. Claim 25 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Dickerson in view of Walker or Cutler in view of Walker, or James in view of Walker. Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Taylor or Cutler or James or

Dickerson. Claim 28 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Taylor or Cutler or James. Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Taylor in view of Cramer, United States Patent Number: 689,464 (hereinafter: Cramer). Claim 23 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Taylor or Cutler or James. Claim 25 has been cancelled, thereby rendering moot the rejections to claim 25 under this section. Applicant respectfully traverses the remaining rejections under this section.

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) the claimed invention must be considered as a whole; (B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) reasonable expectation of success is the standard with which obviousness is determined. *See MPEP § 2141 and Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 220 USPQ 182, 187 n.5 (Fed. Cir. 1986).

Applicant contends that the elements of independent claims 1, 18 and 31 are not obvious in view of the cited references. With particular attention to independent claim 1, but is generally applicable to independent claims 1, 18 and 31, claim 1 recites a marine and pool cleaner having a hanger coupled with the transport assembly, the hanger configured for storing the transmission assembly. Applicant contends that nowhere in any of the references cited by the Patent Office is a marine and pool cleaner having a hanger coupled with the transport assembly discussed, taught or suggested. Therefore, Applicant contends that no suggestion or motivation existed which would have caused one of ordinary skill in the art to modify any of the cited references to arrive at the claimed invention.

Further, claim 18 recites a marine and pool cleaner having a flex drive cable including a strain reliever assembly for minimizing sharp bending. The Patent Office contends that the although neither Taylor, Cutler, James nor Dickerson teach a marine and pool cleaner having a flex drive cable including a strain reliever assembly for minimizing sharp bending, that such elements are obvious in view of Walker. (Office

Action, Page 5). However, Applicant points out that the Walker reference is in a different class as designated by the Patent Office than the other references. Therefore, Applicant contends that it would not have been obvious for one of ordinary skill in the art to combine Walker with either Taylor, Cutler, James or Dickerson to arrive at the claimed invention.

“The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

The Patent Office has proceeded to *impermissibly* use the present patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention.

Based on the above rationale, Applicant contends that the elements of claims 1, 18 and 31 are not obvious in view of the cited references. Therefore, claims 1, 18 and 31 should be allowed over the prior art of record. Further, dependent claims 2-13 and 15-17 (which depend from independent claim 1), dependent claims 19-24 and 26-30 (which depend from independent claim 18), and dependent claims 32-35 (which depend from independent claim 31) should also be allowed.

CONCLUSION

In light of the forgoing, reconsideration and allowance of the pending claims is earnestly solicited.

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Respectfully submitted on behalf of
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